

REMARKS

Prior to the present response, claims 1-7, 9-17, 19-27 and 29-39 were pending with claims 4, 14, and 24 being withdrawn from consideration. In the present response claims 1, 11 and 21 are amended and claims 5, 15 and 25 are canceled without prejudice or disclaimer. Accordingly, claims 1-3, 5-7, 9-13, 15-17, 19-23, 25-27 and 29-39 currently are pending for consideration. In view of the above amendments and the remarks advanced below, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

Independent claims 1, 11 and 21 are amended herein to recite, among other things, “wherein the received information further comprises information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and the method further comprising the step of displaying or printing each identified quantity of the at least one consumable;” “wherein the received information further comprises information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and further comprising the step of displaying or printing each identified quantity of the at least one consumable;” and “wherein the received information identifies a quantity of the at least one consumable at each of the identified plurality of suppliers, wherein the indication system indicates the identified quantity of the at least one consumable,” respectively.

On pages 3 to 6 of the final office action, the Office rejects claims 1-3, 9-13, 19-23 and 29-39 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Pat. Pub. 2002/0042747 to Istvan (Istvan) and on pages 7 to 8, the Office rejects claims 5-7, 15-17 and 25-27 under 35 U.S.C. § 103(a) as allegedly being obvious over Istvan in view of the Office Depot Website (previously cited). These rejections are respectfully traversed.

With respect to independent claims 1 and 11 which are now amended recite, among other things, the features of “wherein the received information further comprises information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and the method further comprising the step of displaying or printing each identified quantity of the at least one consumable.” Similar features are now recited by independent claim 21 in the context of a system. In contrast, the Istvan document describes a system (1300) for ordering and monitoring consumables for a printer. More specifically, Istvan discloses:

The user customization component 1320 may be an optional component that allows the user to customize certain information retrieval, delivery, and notification features as desired to replace the default settings. For instance, the system 1300 may have default settings for the information to be retrieved upon detection of a low-ink level signal, the information to be delivered to the user, and the notification format. The information to be retrieved may include, for example, the cartridge model(s) for the printer 1202, the on-line suppliers with pricing and ordering information, and the user's wallet information including credit card number, shipping information, and the like. The printer information can be obtained from the printer 1202. For example, the STB 108 connected to the printer 1202 includes the printer driver or other communication mechanism from which information on the printer type and model may be retrieved. The suitable cartridge model can be identified, for instance, from the printer 1202 or from another source 104 based on the printer information. The on-line information may be retrieved using the interactive system 100 of FIG. 1. The wallet information may be stored, for example, in the STB 108, a smartcard for use with the STB 108, or a server accessible via the interactive system 100. All or part of the retrieved information may be bundled with the low-ink level notification message and delivered to the user according to the notification format. (Paragraph 0075)

Also, the Office admits, Istvan fails to teach or suggest that monitoring system (1300) is in a printer itself. However, the Office appears to take Official Notice that it is well known to provide a printer with a monitoring/ordering system in a printer. Applicants respectfully request that the Office provide such specific references teach such a combination or configuration in any subsequent Office Action.

Further, Applicants contend that there is simply no description in the Istvan publication that can be considered to reasonably disclose or suggest that monitoring system (1300) be modified in such a manner to be placed within the printer, as presently claimed. Further, the Istvan document also fails to describe or suggest the claimed features relating to the received information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and displaying or printing each identified quantity of the at least one consumable, as now recited in claims 1, 11 and 21.

For at least these reasons, the Istvan fails to describe every limitation set forth in independent claims 1, 11 and 21, and therefore Istvan does not make obvious the claimed subject matter.

It is respectfully submitted that the Istvan publication, taken in combination with Office Depot, also fails to describe, teach or suggest the combinations and features set forth in amended independent claims 1, 11 and 21. In the Office Action, the Office

acknowledges that Istvan does not disclose the claimed features of “wherein the received information further comprises information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and the method further comprising the step of displaying or printing each identified quantity of the at least one consumable,” and similar subject matter recited in amended claim 21, but goes on to assert that previously cited Office Depot discloses such features.

Before proceeding with an analysis of these statements, the Examiner’s attention is directed to MPEP § 2143: **Basic Requirements of a *Prima Facie* Case of Obviousness**. As stated therein, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations” (emphasis added). It is respectfully submitted that the rejection fails to meet these required criteria on several levels.

First of all, the archived website of Office Depot, which is relied upon for teaching a supplier providing information involving available quantity, price, and a way of purchasing at least one consumable, does not remedy the shortcomings of Istvan pointed out above. For instance, the printout of the Office Depot web page provided with the action does not teach or suggest that the claimed features relating to the received information identifying a quantity of the at least one consumable at each of the identified plurality of suppliers, and displaying or printing each identified quantity of the at least one consumable, as presently claimed. Applicants contend that there is simply no suggestion within these documents that would have motivated one of ordinary skill in the art to provide a web page such as the applied Office Depot Website printout in combination with a peripheral device proposed by the Office.

In addition to the patentable distinctions pointed out above with regard to independent claims 1, 11 and 21, the Office asserts that the printer of Istvan mentions the use of web browser capable of accessing the on-line shopping. With reference to paragraph [0008] of Istvan, the Office goes on to assert, “the Istvan reference discloses that a web browser is launched to provide online shopping capabilities to the user.” Further, the

Office asserts that “the previously cited Office Depot archived website ... shows the Office Depot website showing various printer cartridges to be ordered.” This assertion means the Office Depot website was merely cited to show a price for cartridges that can be ordered and means that Office Depot can access web pages. However, it is respectfully submitted that there is no motivation found in any of the Istvan and Office Depot Website documents that would have led one of ordinary skill in the art to make the modifications suggested by the Office. For example, while paragraph [0008] of Istvan vaguely describes using a browser, it is only in the broad context of contacting a particular vendor system to order a consumable. There is no mention in Istvan of using the browser to receive and indicate information relating to a price of at least one consumable, as claimed. Also, neither Istvan nor the Office Depot documents mention anything with respect to using a browser of a peripheral device or printer, much less requesting, with a peripheral device or printer via a communications network connected to the peripheral device, an identity of at least one supplier for the at least one consumable for the peripheral device or printer, as presently claimed. Absent any evidence in the prior art for the proposed combination and requisite modifications to meet the claimed subject matter, it is respectfully submitted that Office’s reasons for modifying the prior art amount to mere assertions that the applied references can be combined. However, MPEP § 2143.01 instructs that the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness unless the prior art also suggests the desirability of the combination. Accordingly, the features of claims 1, 11 and 21 recite additional distinctions not taught or suggested in the Istvan and Office Depot Website documents.

For at least these reasons, the Istvan publication, taken in combination with the Office Depot document, fails to teach or suggest each and every limitation set forth in independent claims 1, 11 and 21, as presently claimed. Additionally, the Office’s motivation for the proposed modification is unsubstantiated and therefore conclusory. Thus, the rejection fails to establish a *prima facie* case of obviousness within the purview of Section 103. Accordingly, this rejection should be withdrawn.

The remaining rejected claims depend from one of claims 1, 11 and 21, and therefore are allowable for at least the reasons pointed out above. Additionally, these dependent claims recite combinations of features defining further points of distinction not

taught by the Istvan and Office Depot documents, whether taken alone or in combination. However, because the distinctions set forth in the independent claims is clear, Applicants will not belabor a detailed discussion of the separately patentable features recited in each and every dependent claim at this time. However, Applicants reserve the right to argue these distinctions at a later time, if necessary.

In view of all of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of the claims, and allow the present application without further delay. Such allowance is earnestly solicited.

Respectfully submitted,

Date: August 12, 2008

/Sean A. Pryor, Reg. #48103/
Sean A. Pryor

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1014
Facsimile: (585) 263-1600